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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,205	12/22/2000	Charles L. Brabenac	884.336US1	1318

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EXAMINER

TRUJILLO, JAMES K

ART UNIT	PAPER NUMBER
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2116

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application, or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/746,205

Applicant(s)

BRABENAC, CHARLES L.

Examiner

James K. Trujillo

Art Unit

2116

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 2,5,9,12,13 and 15-38.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s) _____.
13. ☐ Other: _____.

**A. ELAMIN
PRIMARY EXAMINER**

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's arguments with respect to claims 2, 5, 9, 12, 13 and 32 appears to be the same as in the last office action. It is believed that those arguments were previously addressed in the last office action. However for applicant's convenience the basis for the arguments will be readdressed infra.

Applicant argues in substance that there is no motivation found of record to combine Graham with McKaughan and uses impermissible hindsight and that McKaughan is not analogous art. Specifically, applicant states:

"There is no indication in Graham that Graham is attempting to or desiring to reduce power consumption. In fact, even the Examiner states that Graham is 'silent with respect to the power consumption aspect of his particular invention.' Therefore, there is simply no indication in the Action that there is motivation in Graham to look to McKaughan to reduce power consumption (or to modify Graham to include a wake-up message or a power-managed computer). And thus, there is no motivation in the record to combine the references to arrive at the present claims.

There must be evidence of record to suggest the combination. Applicant respectfully requests that the Examiner place a reference in the file that indicates motivation in Graham to look to McKaughan for motivation to reduce power consumption in Graham. In the alternative, Applicant requests that the Examiner place an affidavit of personal knowledge as to this motivation being gleaned only from knowledge, which was within the level of ordinary skill at the time the claimed invention, was made (and not from Applicant's disclosure). Absent such a reference or affidavit, the proposed combination is impermissible hindsight."

The examiner agrees that motivation is not found in Graham, that is why reference to McKaughan is made for motivation. It appears that the applicant believes that because Graham does not suggest conserving power in his disclosure that one of ordinary skill would not attempt to modify his teachings to reduce power consumption in his system with the teachings of McKaughan and is thus nonanalogous art. However, in order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. In response to applicant's argument that McKaughan is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Applicant's claimed invention recites "sending a wake-up message to a power-managed host computer that is operable in either a power-managed state or an operational state". Applicant is directed to pages 4 and 5 of the last office action. Motivation is found in McKaughan at col. 3, lines 15-30, col. 10, lines 50-55 and col. 6, line 60 through col. 7, line 9. It is there that McKaughan provided motivation of conserving energy of a computer. By combining the teachings of Graham with the teachings McKaughan the modified result would have the advantages of reducing power consumption as taught by McKaughan. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Because motivation is found in McKaughan there is no need for submission of an affidavit of personal knowledge as to this motivation being gleaned only from knowledge, which was within the level of ordinary skill at the time the invention was made. Further, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as shown above motivation comes from McKaughan as of one of ordinary skill in the art would understand because McKaughan is pertinent to the particular problem with which the applicant was concerned.

Applicant's arguments with respect to claims 33-38 will be addressed below.

Applicant argues that there is no motivation to combine the references of Graham and Novoa. Specifically, applicant argues that the statement in the rejection that "Graham suggests that such a filter would be useful for providing security in such a network system" is not supported. Applicant is directed to col. 1, lines 60-64. It is noted that "a filter" is equated in Graham as a "dynamic port". As quoted in Graham, "dynamic ports are frequently used, for example to provide for security or for improved resource sharing". No reference is need because the suggestion is in fact found in Graham.

Applicant further argues that the examiner's proposed modification of the second filter of Novoa by Graham destroys the purpose of Novoa, which includes using an encryption scheme to discriminate between authorized wake-up packets and unauthorized wake-up packets. The examiner disagrees. It appears that the applicant has misinterpreted how Graham would be used to modify the second filter of Novoa. It appears that the applicant believes that the modification proposed by the examiner would have the second filter of Novoa be completely replaced by the filter of Graham. However, the combination as described in the last office action states that the second filter would include the filter of Graham, not replace the filter of Novoa. This would not destroy Novoa as applicant argues. The modification as proposed by the examiner would enhance the filter of Novoa.